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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,925	04/26/2000	John Albert Kembel	10351-0007	1658
42179	7590	07/28/2008		
INNOVATION MANAGEMENT SCIENCES P. O. BOX 1169 LOS ALTOS, CA 94023-1169			EXAMINER AVELLINO, JOSEPH E	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/558,925

**Applicant(s)**

KEMBEL ET AL.

**Examiner**

Joseph E. Avellino

**Art Unit**

2146

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-41, 50, 52-55 and 60-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-41, 50, 52-55 and 60-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-543)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 31-41, 50, 52-55, 60-77 are pending in this application; claims 31, 42, 50, and 62 independent.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Terminal Disclaimer***

3. The terminal disclaimer filed on December 21, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent 7,356,569 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 31-41, 50, 52-55, 60-77 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to

make and/or use the invention. Exemplary claim 31 recites "obtaining *without the use of a Web browser* first internet content...and rendering the first internet content...". The specification does not provide for a non-web browser program to render the internet content. Applicant has not provided an explicit definition for a "web browser" and therefore broad consideration is taken. Microsoft Computer dictionary defines a "web browser" as program which can display internet content. As such, Applicant's method which obtains web browser content and then renders the internet content can be construed as a Web browser. Applicant *describes* similarities and differences between prior art Browsers and the Network Information Monitors (NIMs), however does not *explicitly* define what a "browser" actually means. Applicant defines a NIM as "a fully configurable frame with one or more controls, the frame through which content is optionally presented" (p. 7), however this appears to be equivalent to the browser described in Ko (see rejections below). Applicant is invited to specify where in the specification where the invention is able to obtain internet content and render the content without the use of a Web browser. Clarification is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 31-41, 50, 52-55, 60-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant identifies obtaining and rendering the content without a web browser, however any program which renders

internet content can reasonably be construed as a web browser, and therefore cannot be downloaded without using a web browser. For examination purposes, the Office will construe a "browser" as a software program that implies rigid constraints with respect to framing the web page.

8. Claims 31-41, 50, 52-55, 60-77 are further rejected under 35 USC 112, second paragraph as being indefinite for containing negative limitations which attempt to claim the invention by including what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). Correction is required.

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 31-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe (USPN 6,006,252) in view of Ko et al. (USPN 6,292,185) (hereinafter Ko).

11. Referring to claim 31, Wolfe discloses a method for presenting Internet content to a user of a computing device, comprising:

retrieving without the use of a Web browser, a first internet content (i.e. supplemental content) that is programmed in a format readable by a web browser program (Figures 13, 14, 16, and 19; col. 8, lines 30-65); and

rendering the first internet content to provide a visual manifestation of the first internet content on an output means of the computing device, wherein the visual manifestation of the first internet content is not confined by a window of a Web browser program (i.e. program 1535 displays the information, and therefore does not utilize the browser to render the supplemental information, and therefore the supplemental information cannot be confined by the web browser program), the internet content is rendered independently from a web browser program (i.e. program 1535 renders the supplemental content independently from the web browser 1530) (col. 8, lines 30-48).

Wolfe does not specifically disclose that the supplemental information contains a definition of a frame for the visual manifestation. In analogous art, Ko discloses another method for presenting internet content which includes defining how a GUI will be tailored in the web page (thereby not being considered a browser as identified by Applicant since the browser is not confined by the rigid constraints of the browser's frame or window, the web page is able to define the look and feel of the frame) (e.g. abstract; Figure 2; col. 5, lines 7-30). It would have been obvious to one of ordinary skill in the art to combine the teaching of Ko with Wolfe in order to allow the supplemental content to tailor program 1535 window with respect to the advertisement, thereby allowing a user to further distinguish their advertisement from another, and allowing a

supplemental content provider to customize the appearance of a graphical web page free from the constraints of the browser as supported by Ko (col. 1, lines 45-50).

12. Referring to claim 32, it is inherent that the definition of the frame is programmed in a format readable by a web browser program since if it is displayed by the web browser program it inherently must be programmed in a way such that the program is able to read the definition of the frame.

13. Referring to claims 33 and 34, Wolfe discloses the invention substantively as described in claims 31 and 32. Since claims 33 and 34 defines a second visual manifestation exactly the same as claims 31 and 32, and Wolfe discloses that multiple supplemental information windows can be rendered simultaneously (Figure 39; col. 18, lines 26-40), Wolfe clearly discloses the use of a second visual manifestation.

14. Referring to claim 37, Wolfe-Ko discloses the Internet content comprises JavaScript (Ko: col. 7, lines 60-67).

15. Referring to claim 42, Wolfe discloses the invention substantively as described in the claims listed above. Wolfe furthermore discloses a second visual manifestation of a frame through which the first visual manifestation is presented (the supplemental information can rotate on a timewise basis (Figure 26a and related portions of the disclosure).

16. Referring to claim 43, Wolfe discloses the receiving step comprises receiving the internet content from the web (Figure 2, ref. 253).

17. Referring to claim 44, Furst discloses the receiving step comprises retrieving the internet content from a memory of the computing device (it is understood that the web page must be stored in memory before it can be rendered) (Figure 2).

18. Claim 46 is rejected for similar reasons as stated above.

19. Claims 50-77 are rejected for similar reasons as stated above since all limitations taught by the newly added claims are either expressly taught or implied by Wolfe and Ko. Furthermore it has been held obvious to make combined components separable. See *Nerwin v. Erlichman* 168 USPQ 177 (1969).

20. Referring to claims 35 36, and 45, Wolfe-Ko discloses the invention substantively as described in claim 31. Wolfe-Ko does not specify that the internet content comprises XML codes and XML tags for the frame definition. However it is well known that XML code is commonly downloaded over the Internet (i.e. web pages) and that in defining the frames of these web pages, XML tags are used in order to correctly define the frame. By this rationale it would have been obvious to one of ordinary skill in the art to include XML tags to the system of Wolfe-Ko to provide a more robust method of coding



the icons and window bars associated with the invention, thereby allowing another method to provide third parties to code applications easily.

21. Referring to claims 38, Wolfe-Ko discloses the invention substantively as described above. Wolfe-Ko does not specifically disclose that JavaScript tags are used to define the frame of the window and bar, yet Ko does disclose that JavaScript can be used instead of VBScripting (see rejections above). However it is well known that JavaScript has the capability of defining a frame for the tool and one of ordinary skill in the art would find it obvious to do so. By this rationale it would have been obvious to one of ordinary skill in the art to include JavaScript tags in the code in order to provide a more robust method of coding the icons and windows and a bar in order to provide a language in which many browsers understand, thereby increasing the accessibility of the invention.

22. Referring to claims 39-41 and 47-49, Wolfe-Ko discloses the invention substantively as described in claim 31. Wolfe-Ko does not disclose that the Internet content includes creating a media player, a calculator or accessing streaming media. However these functions are well known to exist and one of ordinary skill in the art (i.e. calculation applets are prevalent on the web, media players can be inserted into web browsers, which would stream media from servers) would find it obvious to be able to encode a visual manifestation of these applications in order to provide the viewing public a copy of the application, thereby increasing the knowledge of the general public.

***Response to Arguments***

23. Applicant's arguments dated December 21, 2007 have been fully considered but are not persuasive.

24. Applicant argues, in substance, that Wolfe does not disclose obtaining or rendering the first content without the use of a web browser program. The examiner disagrees. Even though a web browser is running on the system of Wolfe. The Examiner construes the steps of obtaining the claimed first internet content of Wolfe to be independent of the web browser request. The Examiner construes the term "obtaining" as broadly as possible and it can be construed that the programs 1525, 1535 "obtain" without a browser since the browser is not involved in the actual request or response and rendering of the supplemental content. Although Applicant alludes that the web browser is needed to send a document such that the program 1525,1535 can access the network stack directly to determine what document the web browser is sending, however any URL being identified in the stack would go through the same process, and therefore the web browser software is not necessarily involved with the obtaining step.

Furthermore, even for the sake of argument, that Wolfe does require the use of the web browser, it is the combination of Wolfe in view of Ko which teaches the invention. Ko teaches that a web browser can be modified such that the internet

content can define the frame for the visual manifestation of the web page. With this in mind, in consideration of how the term "web browser" is interpreted for examination purposes above, Ko discloses a way for a conventional web browser to not be considered a web browser as Applicant describes. As such, the combination of Ko into the system of Wolfe would permit the web browser of Wolfe to behave independently of a prior art browser as described by Applicant since Ko would permit the web page to not be subject to the display constraints of the browser window. As such, even if Wolfe cannot be considered to obtain the internet content without the use of a web browser, it can be reasonably construed that the addition of Ko would make this a moot point. By this rationale, the rejection is maintained.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C. Pwu can be reached on (571)272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph E. Avellino/  
Primary Examiner, Art Unit 2146